

REMARKS

In response to the Official Action mailed on March 27, 2006, the application has been amended. No new matter has been added. Reconsideration of the rejections of the claims is respectfully requested in view of the above amendments and the following remarks.

On pages 2 - 5 of the Official Action, the claims received the following art rejections:

(a) On page 2 of the Official Action, claims 1 - 2 were rejected under 35 USC 103 as unpatentable over JP 07-195189, JP 11-267880, or An et al (U.S. Patent No. 6,033,488, referred to below as An).

(b) On page 3 of the Official Action, claims 3 - 7 were rejected under 35 USC 103 as unpatentable over JP 07-195189, JP 11-267880, or An as applied to claims 1 and 2 and further in view of the description on pages 1 - 4 of the present application.

(c) On page 5 of the Official Action, claims 1 - 7 were rejected under 35 USC 103 as unpatentable over JP 11-791.

These rejections are respectfully traversed.

Amended claim 1 recites a solder consisting of Sn, P, Cu, and a remainder of Pb. Amended claim 1 is supported by Table 1 on page 10 of the application as filed, which shows 7 examples of solders each containing only the four elements Sn, P, Cu, and Pb. None of the cited references discloses or suggests such an alloy.

JP 07-195189 discloses a solder alloy containing Sn, Bi, Cu, Sb, and Pb as essential elements, and optionally containing P. There is no disclosure of an alloy consisting of Sn, P, Cu, and a remainder of Pb as set forth in claim 1.

JP 11-267880 discloses a solder alloy for attaching chip parts or semiconductor parts to a printed circuit board. The alloy contains Sn, Sb, Cu, Ag, P, and Pb as essential elements, and may further include Ge, Ni, Te, Ga, Co, or Cr. Thus, this reference does not disclose an alloy consisting of Sn, P, Cu, and a remainder of Pb.

An discloses a solder alloy containing Sn, Sb, Ag, P, and Pb. It may further include at least one of Cu, Bi, Ni, Ge, Te, Ga, and In. Like the preceding references, it does not disclose an alloy consisting of Sn, P, Cu, and a remainder of Pb.

JP 11-791 discloses a solder and a method of mounting an electronic part. The alloy contains Sn, Cu, Pt, and Pb as essential elements and may further contain P or B. This reference does not disclose an alloy consisting of Sn, P, Cu, and a remainder of Pb.

Thus, since none of the cited references discloses or suggests an alloy having a composition as set forth in claim 1, these references cannot render either claim 1 or claims 2 - 7 which depend from it obvious. Claims 1 - 7 are therefore

allowable.

On page 4, the Official Action cited *In re LaVerne*, 108 USPQ 335 (CCPA, 1956) for the proposition that "a use of a new material in an old patented process is not invention". The Applicants respectfully submit that *In re LaVerne* does not represent the current state of patent law. *In re LaVerne* is not so much as mentioned in *Chisum on Patents*, the definitive work on modern patent law, and the Federal Circuit does not appear to have ever relied upon this case. It states a *per se* rule instead of relying on objective evidence, and it ignores the requirement that the prior art or the knowledge generally available to one skilled in the art provide some objective teaching that would lead a person skilled in the art to combine the relevant teachings of the references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). An objective analysis of the references shows that none of the cited references contains any suggestion of using a solder like the claimed alloy for use in soldering to a surface coated with nickel by electroless plating with a phosphorus-containing plating solution. Therefore, they contain no teachings that could be combined to result in the methods or uses for the alloy of claim 1 set forth in claims 2 - 7.

New claims 8 and 9 describe additional features of the present invention. These claims are allowable as depending from claim 1.

In light of the foregoing remarks, it is believed that the present application is in condition for allowance. Favorable consideration is respectfully requested.

Respectfully submitted,



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